

II. **Remarks**

Reconsideration and further examination are requested.

A. Disposition of the Claims

Claims 1-2 & 4-32 are pending in the application.

Claims 2, 5, 7-10, 21-23, 25-26, & 28-30 are withdrawn from consideration.

No claim is allowed.

Claims 1, 4, 6, 11-20, 24, 27, & 31-32 are rejected.

Claims 1, 11, 13, & 15-17 are currently amended, without prejudice or disclaimer.

Support for each amended claim is found in the as-filed specification and is believed obvious from the record.

Claim 3 was previously canceled, without prejudice or disclaimer.

This amendment adds, changes, and/or deletes one or more claims in this application. A detailed listing of each claim that is, or was, in the application, irrespective of whether or not the claim remains under examination in the application, is presented, with a status identifier.

B. Traversing the Five Rejections under 35 U.S.C. § 103(a)

The Examiner maintains five sets of rejections using one of several combinations of Bickmore (U.S. Pat. No. 5,984,997); Konig (U.S. Pat. No. 5,356,120), Holzl (U.S. Pat. No. 3,565,676), and Umeya (U.S. Pat. No. 5,489,449). Final Office action, p. 5, paras. 15-19. The sets may be divided into two generic types: rejections that do not use the Bickmore patent (Final Office action, p. 5, paras. 16 & 18) and those that do (Final Office action, p. 5, paras. 15, 17, & 18). Each set is traversed under a separate header.

1. Response to the rejections that do not use the Bickmore patent

The rejections that do not use the Bickmore patent include combinations of Konig, Holzl, and Umeya. The teachings of Konig, Holzl, and Umeya lack a reason to use a *metal-containing precursor* that is *metal carboxylate* as recited in the present version of claim 1. Thus, each of the

present rejections that do not use the Bickmore patent should be withdrawn for this reason alone. See Final Office action, p. 5, paras. 16 & 18.

2. Response to the rejections that use the Bickmore patent

The rejections that use the Bickmore patent include rejections based on Bickmore alone (Final Office action, p. 5, para. 15) or in combination with one or more of Konig, Holzl, and Umeya (Final Office action, p. 5, paras. 17 & 19). As to these rejections, the Bickmore patent is not prior art to the proposed version of claim 1, because § 103(c) removes the Bickmore patent from the scope and content of the prior art for obviousness determinations.

More specifically, the relevant bibliographic data is, in tabular form, as follows, where the application or patent number precedes its filing or issuance date, respectively:

The present	Apn is	10/698,564	10-31-2003	Pending	
10/698,564	Div	10/004,387	12-04-2001	6,652,967	11-25-2003
10/004,387	119e	60/310,967	08-08-2001	Expired	
10/004,387	CIP	09/790,036	02-20-2001	6,933,331	08-23-2005
09/790,036	DIV	09/083,893	05-22-1998	6,228,904	05-08-2001

Bickmore	patent is	09/046,465	03-23-1998	5,984,997	11-16-1999
09/046,465	119e	60/057218	08-29-1997	Exp	
09/046,465	119e	60/064,050	11-03-1997	Exp	

One year after the cited Bickmore patent's issuance date (11-16-1999) is 11-16-2000.

Although priority benefit was acknowledged as to the previous version of the claims, Final Office action, p. 6, para. 20, the Examiner urged that benefit was not accorded as of the filing dates of the '036 & '893 applications, because the terms concerning the temperature range were not supported in the as-filed specifications of the '036 & '893 applications. Final Office action, p. 7, para. 20; FOAM, p. 8, para. 16. The Examiner accorded benefit as to the '967 provisional thus making the effective date of the claims 08-08-2001. Final Office action, p. 7, para. 20; FOAM, p. 8, para. 16.

Because the previous version of the claims was accorded an effective date of 08-08-2001, a date after one year following the Bickmore patent's issuance date, the Examiner examined the previous version of the claims as if the Bickmore patent were a § 102(b) reference. Final Office action, p. 7, para. 20; FOAM, p. 8, para. 16.

Because the present set of claims presents an embodiment in which the temperature range has been eliminated from the previous version of the claims, the claims should be accorded an effective date not later than the filing date of the '893 application, i.e., 05-22-1998. Because of this accorded date, the Bickmore patent is disqualified by § 103(c).

Along these lines, there seems to be no disagreement that the cited Bickmore patent is incorporated by reference into the as-filed specifications of the '036 & '893 applications. Final Office action, p. 7, para. 20.

Additionally, in the FOAM, the Examiner expressed a concern about the specification's non-enablement to allow one of ordinary skill in the art to *process[] the stream* at any temperature, e.g., 1,000,000°C. FOAM, pp. 2-3, para. 4. This concern should be addressed by noting that specification must only enable what is claimed, not what is unclaimed. If, for the sake of argument, *processing the stream* at 1,000,000°C failed to *form a vapor stream comprising nucleated nanoscale powders*, then that embodiment would not fall within the scope of the claims, and, more importantly, non-enablement as to this particular embodiment would be irrelevant. Thus, the previously presented enablement rejection should not be re-introduced.

Finally, although § 103(c) removes the Bickmore patent from the scope and content of the prior art for obviousness determinations, § 103(c) does not remove the Bickmore patent for the purposes of novelty, e.g., § 102(f). This is important, because if the Examiner believes that the Bickmore patent is anticipatory, then the undersigned requests a conference with the Examiner to discuss the matter.

In summary, each of the present rejections should be withdrawn.

III. Conclusion

It is believed that the present application is in condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

If a petition for an extension of time is required, then one is requested. The Director is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16-1.17 & 1.21(m) (including deficiencies in payment) which may be required, or credit any overpayment to Deposit Account No. 50-4028.

Respectfully submitted,

Dated: 2008-04-17

By: /Sean Allen Passino/

Sean A. Passino
Reg. No. 45,943
Attorney for Applicant